

Serial No. 09/537,506  
Docket No. 10655.9400

### **REMARKS**

Applicants reply to the Final Office Action mailed on November 22, 2005 within two months. Thus, Applicants request an Advisory Action, if necessary. The Examiner rejects claims 47-55 pending in the application. Applicants amend claims 47, 50, 51, and 53-55. Upon entry of the foregoing amendments, claims 47-55 (2 independent claims; 9 total claims) remain pending in the application. Applicants request reconsideration in view of the above amendments and the following remarks. No new matter is included in the amendments.

#### **New Matter Rejection**

The Examiner objects to Claims 47 and 51 because the Examiner asserts that the new matter is "not supported by the original disclosure." (Page 3) Specifically, the Examiner states that the "added material which is not supported by the original disclosure is as follows: 'resolution template is independent of a type of said financial dispute and resolution templates are available only to issuers.'" (Page 3) Applicants respectfully traverse this rejection. However, in order to expedite prosecution, Applicants have amended claims 47 and 51 to recite "a first user with an Issuer access right" as the user that is selecting from templates "available only to users with an Issuer access right." As such, Applicants assert that claims 47 and 51 are supported by the original disclosure. Accordingly, Applicants respectfully request withdrawal of this rejection.

#### **Rejection Under 35 U.S.C. § 112**

Claims 47 and 51 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states "Claims 47 and 51 recite the limitation 'resolution template is independent of a type of said financial dispute and resolution templates are available only to issuers.' There is insufficient antecedent basis for this limitation in the disclosure." (Page 4) Applicants respectfully traverse this rejection. However, in order to expedite prosecution, Applicants have amended claims 47 and 51 as stated above. Applicants assert that there is sufficient antecedent basis for the amended claims that recite the "electronic dispute resolution templates is independent of a type of said financial dispute, and said predetermined set of electronic dispute resolution templates is available only to users with an Issuer access right." Accordingly, Applicants respectfully request withdrawal of this rejection.

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**Rejections Under 35 U.S.C. § 102(e)**

Claims 47-55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Israel *et al.*, U.S. Patent Application Publication No. US 2004/0210540 A1 ("Israel"). Applicants respectfully traverse this rejection.

In the Claim Rejections section of the Office Action, the Examiner merely repeats the language of each claim and then states "see paragraphs 0009, 0011, 0014, 0016, 00356, 0053, 0060, 0132, 0134-0138, 0144, 0145, 0150, 0151" with reference to the Israel reference (see Page 2). This generic rejection is repeated for each claim. In the "Response to Arguments" section of the Office Action (Pages 8-9), the Examiner simply states "Examiner respectfully disagrees with Applicants' characterization of the prior art" (Page 9) and the Examiner states that "the applicant argues a limitation that is not supported by the specification." As stated above, Applicants have amended independent claims 47 and 51. Applicants respectfully assert that the Examiner has not provided sufficient explanation or support for the Section 102(e) rejection of claims 47-55 by Israel.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To anticipate a claim for a patent, a single prior source must contain each of its limitations. Hybridtech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1376, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). In other words, "every limitation of a claim must **identically** appear in a single prior art reference for it to anticipate the claim." Gechter v. Davidson, 116 F.3d 1454 (Fed. Cir. 1997) (emphasis added). "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558 (Fed. Cir. 1996).

Israel teaches a system that enables adverse parties to conduct and manage a non-judicial dispute resolution. When users of the Israel system add disputes to the system, they are "prompted to select a profile classification as either a plaintiff or a defendant." (Israel Paragraph 0133) The nature of the dispute is selected by the user from a displayed general list and the nature of the dispute is a cause of action recognized by a judicial system such as a bad loan, landlord/tenant dispute, personal injury, and the like. (Israel Paragraph 0134) Thereafter, the user selects "an Opposing Party from a list" or a new Opposing Party. (Israel Paragraph 0135)

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Next, the user enters additional dispute information. The user is prompted to enter additional dispute information (Israel Paragraph 0139) that varies **depending on the nature of the dispute**. Graphic displays may be provided, such as a skeleton for identifying body parts if the dispute involves personal injury. (Israel Paragraphs 0139-0140, Figures 3 and 4)

Accordingly, Israel does not disclose or teach at least "selecting, by said first user, from a discrete, predetermined set of electronic dispute resolution templates, a first template, wherein said predetermined set of electronic dispute resolution templates is **independent of a type of said financial dispute**, and said predetermined set of electronic dispute resolution templates is **available only to users with an Issuer access right**," (emphasis added) as similarly recited in amended independent claims 47 and 51. Accordingly, Applicants respectfully request withdrawal of this rejection.


Dependent claims 48-50 and 52-55 variously depend from independent claims 47 and 51, so dependent claims 48-50 and 52-55 are differentiated from the cited reference for at least the same reasons as set forth above, as well as in view of their own respective features.

#### CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 47-55, fully comply with 35 U.S.C. §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814, including any required extension fees.

Respectfully submitted,

Date: January 18, 2006

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AXP No. TP19990129  
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